

## REMARKS

Claims 6-8 are rejected. Claims 6-8 are amended, and claims 9-13 are added. Claim 6-13 are pending.

Support for the amendments and added claims is found in the specification and drawings as originally filed. No new matter is added. For instance, but without limitation, the specification describes and the drawings illustrate the piercer having a closed tissue piercing tip (72) and a tissue receiving port (78) proximal of the tip, the cutter (96) rotatable and translatable to sever tissue received in port (78), that the source of rotary motion can be external of the biopsy device 40 (e.g. rotary motion can be provided to biopsy device 40 from control unit 100 via flexible shafts 22 and 24) (see page 8, lines 11-26). Figure 7 shows transmission 301 disposed proximally of the piercer. Pages 16-21 describe bevel gears bevel gears 321, 325, 350, and 351. Page 21, lines 17-22 explain that the transmission allows shafts 22, 24 to enter the biopsy device at a right angle to the device center axis, which permits short overall length of the biopsy device. Page 18, lines 28-Page 19, line 20 describe how one portion of the transmission receives rotary motion and provides rotary motion to provide translation of the cutter, and pages 19, line 22- page 20, lines 15 receives rotary motion and provides rotary motion to provide rotation of the cutter. As seen in Figure 7, bevel gear 321 rotates about an axis angled with respect to the axis of rotation of bevel gear 351, and bevel gear 325 rotates about an axis angled with respect to the axis of rotation of bevel gear 350. Figures 3 and 7 taken together illustrate the axis of rotation of bevel gears 350 and 351 are generally parallel to the longitudinal axis of the cutter 96. Page 22, lines 1-8 explain that the firing mechanism operates to fire the distal end of the probe assembly (and so the piercer) into tissue. Page 31, lines 1-9 explain that the spring 217 of the firing assembly drives the piercer 70 toward the target (i.e. tissue).

The Examiner is requested to consider Page 21, lines 17-22 which explain that the transmission allows shafts 22, 24 to enter the biopsy device at an angle (e.g. right angle) to the device center axis, which permits short overall length of the biopsy device.

Objection to Claim 7:

The amendment to claim 7 deletes the portion objected to by the Examiner.

Double Patenting Rejection:

The Examiner is requested to stay the rejection until allowable subject matter is indicated.

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Schwind:

Claim 6 is rejected as anticipated by Schwind. It is respectfully urged that amended Claim is not anticipated by Schwind because Schwind does not disclose one or more of the following:

- a base comprising a firing mechanism;
- a piercer having a tissue piercing tip and a side tissue receiving port.
- a piercer adapted to be carried distally toward a target by operation of a firing mechanism.
- a transmission as recited in amended claim 6.

Withdrawal of the rejection is requested.

Pacala:

Claims 6 and 7 are rejected as anticipated by Pacala. It is respectfully urged that amended claims 6 and 7 are not anticipated by Pacala for at least the following reasons.

Regarding amended Claim 6, Pacala does not disclose or suggest at least one of:

- a base comprising a firing mechanism;
- a probe assembly detachably mounted to such a base;
- a piercer where the piercer has a tissue piercing tip and a side tissue receiving port, or a piercer adapted to be carried distally toward a target by operation of the firing mechanism;
- a transmission operable to provide motion of a cutter.

The Examiner states Pacala teaches a firing mechanism at column 9, lines 17-20. However, this is not a correct characterization of Pacala.

Column 9, lines 17-20 of Pacala describe

"In the test mode, when the foot actuator is acted upon, coring member 170 is moved sequentially from a fully retracted position to a fully extended position and back to the fully retracted position." Underlining added.

The portion of Pacala the Examiner refers to a "test mode", and does not teach or suggest that the device of Pacala has a firing mechanism, or piercer adapted to be carried distally toward a target by operation of the firing mechanism.

The Examiner also states that Pacala discloses a "cutter" 20 as well as coring member 170. However, Pacala describes element 20 as a "coring member 20". Pacala describes a coring member 20 with respect to one embodiment (e.g. Fig 1) and Pacala describes a coring member 170 with respect to another embodiment in Figure 15.

It is respectfully urged that the Examiner has misapplied the coring member of Pacala twice, once as a cutter, and once as a piercer, when in fact both 20 and 170 of Pacala refer to a coring member.

Further, it is respectfully urged that the Examiner has not shown how Pacala discloses a base assembly and a probe detachably mounted to the base. In addition, because Pacala does not disclose a cutter as recited in Claim 6, Pacala also does not disclose a transmission operable to provide motion of a cutter.

Regarding Claim 7, it is respectfully urged that Pacala does not anticipate amended claim 7 because Pacala does not teach or suggest at least one or more of:

a base including a firing mechanism

a probe assembly detachably mounted to a base;

a probe assembly comprising a cutter assembly and a piercer assembly;

a piercer having a closed distal tip and a tissue receiving port proximal of the closed tip;

a transmission operative to receive rotary motion about an axis angled with respect to a cutter axis and transmit rotary motion to a cutter assembly gear mechanism.

Accordingly, withdrawal of the rejection over Pacala is requested.

Hibner (US 6120,462):

Claim 6 and 8 are rejected as anticipate by Hibner. With respect to amended Claim 6, it is respectfully urged that Hibner does not teach or suggest the combination of a base including a firing mechanism, a probe assembly detachably mounted to the base and having a cutter assembly and a piercer adapted to be carried distally by operation of the firing mechanism, and a transmission operable to provide motion of a cutter, wherein the transmission receives rotary motion about an axis angled with respect to the cutter's longitudinal axis.

Regarding amended Claim 8, it is respectfully urged that Hibner '462 does not teach or suggest a first or second transmission portions receiving rotary motion about an axis and transmitting rotary motion about a axis angled with respect to input axis to provide motion of a cutter.

Conclusion:

The examiner is requested to reconsider and allow the claims as amended.

Respectfully submitted,

/Gerry Gressel/

Gerry Gressel, reg#34,342